

REMARKS

The Office Action rejects claims 30, 31, 33, 34, and 57 under 35 U.S.C. § 112, second paragraph. Office Action at p. 2. Further, the Office Action rejects claims 19, 21-23, 29-31, and 33 under 35 U.S.C. § 103(a) over various combinations of Okada (Published U.S. Patent Application No. 2001/0002608), Sasaki et al. (U.S. Patent No. 4,985,100), JP 3-114737 (hereafter "JP '737"), Miyamoto et al. (U.S. Patent No. 5,399,225), Irie (U.S. Patent No. 4,468,267), and Kondo et al. (U.S. Patent No. 5,413,653). Id. at pp. 2-4. The Office Action also rejects claims 24, 25, and 34 under U.S.C. § 103(a) as being obvious over the foregoing references in combination with Caretta et al. (Published U.S. Patent Application No. 2001/0042586). Id. at pp. 4-5. The Office Action also rejects claims 56 and 57 under U.S.C. § 103(a) as being obvious over various combinations of Okada, Sasaki et al., JP '737, Miyamoto, Irie, and Kondo "and further in view of the admitted state of the prior art or GB 1,048,241." Id. at p. 5.

By this Reply, Applicant has amended independent claim 19 to recite "[a] method of assembling tyres for vehicle wheels with an apparatus for assembling vehicle tires, the apparatus including a primary drum and a single auxiliary drum, the method comprising" and "disposing a belt structure on the single auxiliary drum of the apparatus." Additionally, Applicant has amended independent claim 30 to recite "a single auxiliary drum . . . wherein the apparatus includes at least one device that disposes the carcass structure on the primary drum by assembling component parts of the carcass structure on the primary drum." Additionally, Applicant has added new claim 58, which depends from independent claim 30. Applicant respectfully submits that the originally filed application and drawings fully support the amendments to the claims.

No new matter has been added. Claims 19, 21-25, 29-31, 33, 34, and 56-58 are currently pending.

Rejection Under 35 U.S.C. § 112, Second Paragraph

Regarding the rejection of claims 30, 31, 33, 34, and 57 under 35 U.S.C. § 112, Applicant respectfully submits that these claims fully comply with the provisions of § 112, second paragraph. Compliance with § 112, second paragraph, requires only that the claim language allows a person of ordinary skill in the art to ascertain the scope of the claims and what Applicant regards as the invention. M.P.E.P. § 2173. If the claim language "apprises one of ordinary skill in the art of its scope" and provides "clear warning to other as to what constitutes infringement," the claims meet the definiteness requirement of § 112, second paragraph. M.P.E.P. § 2173.02. Furthermore, "breadth is not indefiniteness." M.P.E.P. § 2173.04.

The Office Action bases the § 112 rejection on the following assertion:

The last three lines of claim 30 as amended are still arguably ambiguous as it is not entirely clear what additional apparatus features are required by these lines. In particular, these lines now define that "the apparatus disposes the carcass structure on the primary drum" but no apparatus structure was previously defined in the claim that would be capable of functioning in this manner. Note for example that devices for application of belt layers are defined earlier in the claim but no equivalent devices or structure are defined for the carcass component parts. An ambiguity is therefore still present in assessing the scope of the claim insofar as it is not clear what if any additional structural apparatus requirements are provided by these lines. In other words, these lines as presently phrased ("wherein the apparatus disposes") would normally be read as further defining functional capabilities of apparatus parts *that were already defined* earlier in the claim. As no apparatus parts are defined that would be capable of providing this function, the scope of the claim in this regard remains indefinite.

Office Action at p. 2. Applicant notes that "there is nothing inherently wrong with defining some part of an invention in functional terms." M.P.E.P. § 2173.05(g) Additionally, contrary to the implication of the Office Action, the version of claim 30 presented in Applicant's Reply filed on February 26, 2010 did recite structure that "disposes the carcass structure on the primary drum by assembling component parts of the carcass structure on the primary drum." Specifically, claim 30 recited the "apparatus" itself as the structure that performed this act. Applicant respectfully submits that the claim need not recite any more structure than this to comply with the provisions of § 112, second paragraph, as a person of ordinary skill in the art could readily ascertain whether an apparatus "disposes the carcass structure on the primary drum by assembling component parts of the carcass structure on the primary drum." An apparatus either performs this step or it does not, the claim need not recite any specifics regarding how or with what specific components an apparatus performs the task to allow a person of ordinary skill in the art to ascertain whether the apparatus performs the task.

Thus, Applicant respectfully submits that the version of claim 30 presented in Applicant's Reply filed on February 26, 2010 fully complies with the provisions of § 112, second paragraph. It appears that the rejection stems from the Examiner confusing breadth with indefiniteness.

Nonetheless, in the interest of advancing prosecution, Applicant has amended claim 30 to recite "wherein the apparatus includes at least one device that disposes the carcass structure on the primary drum by assembling component parts of the carcass structure on the primary drum" (emphasis added). Applicant respectfully submits that

the amendments to claim 30 address the concerns expressed by the Office Action in connection with the § 112 rejection. Accordingly, Applicant respectfully requests withdrawal of the rejection of claims 30, 31, 33, 34, and 57 under 35 U.S.C. § 112.

Rejections of Claims 19, 21-23, 29-31 and 33 Under 35 U.S.C. § 103(a)

Regarding the rejection of claims 19, 21-23, 29-31 and 33 under 35 U.S.C. § 103(a), Applicant respectfully submits that the cited references cannot support a *prima facie* case of obviousness because a number of the cited references teach away from a number of the features recited in the claims. A reference that teaches away from a claimed combination generally cannot support a *prima facie* case of obviousness of that claimed combination. McGinley v. Franklin Sports, Inc., 262 F.3d 1339, 1354 (Fed. Cir. 2001), citing In re Gurley, 27 F.3d 551, 553 (Fed. Cir. 1994). A reference teaches away from a claimed invention if reading the reference would discourage a person of ordinary skill in the art from implementing the claimed invention. Tec Air, Inc. v. Denso Mfg. Michigan Inc., 192 F.3d 1353, 1360 (Fed. Cir. 1999), citing In re Gurley, 27 F.3d 551, 553 (Fed. Cir. 1994).

Claims 19, 21-23, and 29 recite, *inter alia*, "A method of assembling tyres for vehicle wheels with an apparatus for assembling vehicle tires, the apparatus including a primary drum and a single auxiliary drum, the method comprising: . . . disposing a belt structure on the single auxiliary drum of the apparatus; applying a tread band onto the belt structure; . . . wherein applying the tread band is carried out by winding up at least one continuous strip element of elastomer material in contiguous circumferential coils around the belt structure; . . . wherein during disposing the belt structure on the auxiliary

drum, the auxiliary drum is arranged in a coaxial-alignment relationship with the primary drum and interacts with devices for application of the belt structure; wherein after disposing the belt structure and before winding up said at least one continuous strip element of elastomer material, a step is carried out of moving the auxiliary drum away from a vertical plane containing the rotation axis of the primary drum towards a delivery member that feeds the strip element forming the tread band around the belt structure with the auxiliary drum positioned away from the vertical plane containing the rotation axis of the primary drum, starting from said coaxial-alignment relationship with the primary drum" (emphasis added). Each of claims 30, 31, and 33 includes similar features.

Applicant respectfully submits that Sasaki and JP '737 teach away from a number of the foregoing features. For example, Sasaki and JP '737 teach away from using an apparatus with a "single auxiliary drum" as recited in the claims. Additionally, Sasaki and JP '737 teach away from applying the tread band in a different position than the belt structure. Furthermore, Applicant respectfully submits that Sasaki and JP '737 teach away from "applying the tread band . . . by winding up at least one continuous strip element of elastomer material in contiguous circumferential coils" as recited in the claims.

Sasaki and JP '737 both disclose inventions focused on accelerating the manufacture of tires. See Sasaki at col. 1, ll. 52-60, col. 2, ll. 53-63, and col. 5, ll. 6-8; and JP '737 at English Abstract. Specifically, each reference discloses a system directed toward reducing tire-production time in prior systems that construct a "belt cover layer" or a "cap layer" (not the tread band) by spirally winding cords. See Sasaki

at col. 1, ll. 47-51; and JP '737 at English Abstract. Sasaki bemoans that constructing a portion of a tire, such as the "belt cover layer," by spirally winding cords "requir[es] a very long time," undesirably increasing the time required to construct the tire. Col. 1, ll. 56-60.

The references deal with this problem by constructing the belt and tread of each tire at a first position and winding the "belt cover layer" or "cap layer" at a second position. Sasaki at col. 1, ll. 52-60, col. 2, ll. 53-63, col. 3, l. 40-col. 4, l. 58, and col. 5, ll. 6-8; and JP '737 at English Abstract. More particularly, the system of each reference includes two drums on which to construct each assembly of a belt, "belt cover layer" or "cap layer," and tread for a tire, so that the system can build the "belt cover layer" or "cap layer" of one tire on one drum while simultaneously building the belt and tread of another tire on the other drum. See, e.g., Sasaki at Abstract; col 2, ll. 7-63; col. 3, ll. 10-20; col. 4, ll. 21-58; and Fig. 1; JP '737 at English Abstract and Fig. 1. By constructing both the belt and tread at one position while the protracted winding of the "belt cover layer" or "cap layer" occurs at a different position, Sasaki and JP '737 disclose that the system regains some of the efficiency lost by employing spiral winding to construct the "belt cover layer" or "cap layer." Sasaki at col. 2, ll. 53-63, col. 4, ll. 44-58, and col. 5, ll. 6-8; and JP '737 at English Abstract.

Applicant respectfully submits that these disclosures would discourage a person of ordinary skill in the art from implementing Applicant's claimed invention. Sasaki and JP '737 would discourage a person of ordinary skill in the art from using an apparatus with a "single auxiliary drum" as recited in the claims because doing so would preclude using the references' disclosed approach of simultaneously building different parts of

two tires. Thus, a person of ordinary skill in the art would understand that using a system with a "single auxiliary drum" would undermine the references' disclosed goal of accelerating tire production.

Additionally, with their emphasis on constructing the belt and the tread at the same position to regain some efficiency in the manufacturing process, Sasaki and JP '737 would discourage a person of ordinary skill in the art from configuring a system "wherein during disposing the belt structure on the auxiliary drum, the auxiliary drum is arranged in a coaxial-alignment relationship with the primary drum" and "a delivery member [] feeds the strip element forming the tread band around the belt structure with the auxiliary drum positioned away from the vertical plane containing the rotation axis of the primary drum." Indeed, the disclosure that constructing a tire component by spirally winding coils undesirably increases the time required to construct the tire would discourage a person of ordinary skill in the art from implementing any system wherein "applying the tread band is carried out by winding up at least one continuous strip element of elastomer material in contiguous circumferential coils." Sasaki and JP '737 would likewise discourage a person of ordinary skill in the art from implementing the similar features of claims 30, 31, and 33.

With Sasaki and JP '737 teaching away from the claimed combinations, it appears that the Office Action's idea to combine the teachings of the cited references in the suggested manner must have come from Applicant's own disclosure. The Office Action must not succumb to hindsight and use Applicant's disclosure "as a guide through the maze of prior art references, combining the right references in the right way so as to achieve the result of [Applicant's claimed invention]." Grain Processing Corp.

v. American Maize-Products, 840 F.2d 902, 907 (Fed. Cir. 1988), citing Orthopedic Equipment Co. v. United States, 702 F.2d 1005, 1012 (Fed. Cir. 1983).

Applicant respectfully submits that the Office Action takes exactly this prohibited approach. With Applicant's disclosure as a recipe, the Office Action selects reference after reference in attempt to find all of the features of Applicant's claimed invention. In doing so, the Office Action ultimately resorts to no less than six references. Thus, Applicant respectfully submits that the Office Action resorts to improper hindsight reconstruction of Applicant's claims based on Applicant's own disclosure.

For at least the foregoing reasons, Applicant respectfully maintains that the Office Action does not establish a *prima facie* case of obviousness of claims 19, 21-23, 29-31 and 33. Accordingly, Applicant respectfully requests withdrawal of the rejections of these claims under 35 U.S.C. § 103(a).

Rejection of Claims 24, 25, and 34 Under 35 U.S.C. § 103(a)

Regarding the rejection of claims 24, 25, and 34 under 35 U.S.C. § 103(a) as being unpatentable over various combinations of references that include Caretta, Applicant respectfully submits that the Office Action does not establish a *prima facie* case of obviousness. In addition to the above-discussed deficiencies of the rejections of independent claims 19 and 30, Applicant respectfully submits that Caretta teaches away from the Applicant's claimed invention. Applicant's Reply of June 23, 2009 explains this additional deficiency of the prior art pages 20 and 21, yet the present Office Action and the Office Action of August 31, 2010 both fail to even discuss this matter. Additionally, as with the rejections of claims 19, 21-23, 29-31, and 33, Applicant

respectfully submits that the rejection of claims 24, 25, and 34 resorts to improper hindsight reconstruction and uses Applicant's disclosure "as a guide through the maze of prior art references, combining the right references in the right way so as to achieve the result of [Applicant's claimed invention]." Indeed, the rejection of claims 24, 25, and 34 resorts to citing no less than seven references. Thus, Applicant respectfully submits that the Office Action does not establish a *prima facie* case of obviousness of claims 24, 25, and 34. Accordingly, Applicant respectfully requests withdrawal of the rejection of claims 24, 25, and 34 under 35 U.S.C. § 103(a).

Rejection of Claims 56 and 57 Under 35 U.S.C. § 103(a)

Applicant respectfully submits that the Office Action also fails to establish a *prima facie* case of obviousness of claims 56 and 57. In order to establish a *prima facie* case of obviousness, the record must "include findings of fact concerning the state of the art and the teachings of the references" The Manual of Patent Examining Procedure ("M.P.E.P.") § 2141(II) (8th ed., rev. 6, July 2008) (relying on KSR Int'l Co. v. Teleflex Inc., 127 S. Ct. 1727, 82 U.S.P.Q.2d (BNA) 1385 (2007), and confirming the legal framework established by Graham v. John Deere Co., 383 U.S. 1, 17, 148 U.S.P.Q. 459, 467 (1966)). Moreover, "[o]nce the findings of fact are articulated, [the rejection statement] must provide an explanation to support an obviousness rejection under 35 U.S.C. [§] 103." Id. If it is found that the prior art references fail to disclose all of the subject matter recited in a claim, the rejection statement "must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art." M.P.E.P. § 2141(III).

Here the Office Action merely asserts that the features recited in claims 56 and 57 were known and suggests that it would have therefore been obvious to modify one or more of Okada, Sasaki et al., JP '737, Miyamoto, Irie, and Kondo to include the recited features. See Office Action at p. 5. Such conclusory arguments cannot establish a *prima facie* case of obviousness. To establish a *prima facie* case of obviousness, the Office Action must provide a clear explanation with rational underpinnings that demonstrates why a person of ordinary skill in the art would have found the claimed subject matter obvious. M.P.E.P. § 2142.

Additionally, as with the rejections of claims 19, 21-23, 29-31, and 33, Applicant respectfully submits that the rejection of claims 56 and 57 resorts to improper hindsight reconstruction and uses Applicant's disclosure "as a guide through the maze of prior art references, combining the right references in the right way so as to achieve the result of [Applicant's claimed invention]." See Grain Processing Corp., Supra. Indeed, the rejection of claims 56 and 57 resorts to citing no less than seven references.

For at least the foregoing reasons, Applicant respectfully submits that the Office Action does not establish a *prima facie* case of obviousness of claims 56 and 57. Accordingly, Applicant respectfully requests withdrawal of the rejections of these claims under 35 U.S.C. § 103(a).

Conclusion

In view of the foregoing amendments and remarks, Applicant respectfully requests reconsideration of this application and the timely allowance of the pending claims.

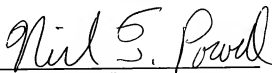
The Office Action contains characterizations of Applicant's specification, claims, and the related art with which Applicant does not necessarily agree. Unless expressly noted otherwise, Applicant declines to subscribe to any statement or characterization in the Office Action.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account no. 06-0916.

If the Examiner believes a telephone conversation might advance prosecution, the Examiner is invited to call Applicant's undersigned agent at 202-408-4492.

Respectfully submitted,

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By: 

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